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EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

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Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 3622



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/768,990

Filing Date: January 23, 2001

Appellant(s): HAMMERSTAD, DIANE R.

MAILED

JUN 14 2006

GROUP 3600

Raymond A. Jenski
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 5/9/2006 appealing from the Office action mailed 10/31/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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6,047,327	Tso	4-2000
2002/0082912	Batachia	6-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts (5,937,392) in view of Tso (6,047,327) in view of Batachia (2002/0082912).

Claims 1-6 and 9-13:

Alberts discloses that an ad can be targeted to profiled users and that ads can be targeted for particular times:

“(5) Alternatively, an advertiser may want a concentration or intensification of ads at particular times, perhaps in response to a profile of users, e.g., different times for children versus adults, or for people accessing the site from home versus work” (col 1, lines 43-50);

(12) The present invention provides an integrated system that allows ads to be served in a highly flexible and accurate manner a desired number of times throughout the day and evenly distributed throughout the day, or intensified at times if desired. Different ads can be served based on different triggering events, such as the location of the user, the type of information being accessed by the user, or the categories accessed” (col 2, lines 30-40).

Notice that Alberts designates that times vary depending upon who the user is receiving the ad. For example, when an ad is slated for children then that ad could be targeted for time slots before 10pm. Then, when a user utilizes the system, the system would check if the user is a

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child and also what time it is. The ad slated for children would only be shown to children before 10pm.

Alberts further discloses targeting users based location, particular users, and/or time of day:

“(10) The system can predictively model the number of hits to control the distribution of serves, either to ensure even distribution, or to concentrate ads during particular times. The system also preferably has triggering information that allows ads to be targeted. Ads can be targeted to users seeking certain types of information, e.g., on a yellow pages system or on a search engine, access to "photography" could cause the serving of an ad for a manufacturer of film; to users from particular geographic locations; to particular users; or to users at different times of the day” (col 2, lines 15-25).

Alberts further discloses scheduling ads, scheduling ads based on user activities, adapting for time zones, adapting for regions, adapting for time regions:

“(27) While the counters are used to provide an appropriate balance in the numbers of serves for each ad relative to the others, other methods can be used to provide appropriate distribution throughout the day. FIG. 5 is a graph representing how usage might vary throughout one day from midnight to midnight (the graph here is merely illustrative and is not meant as a precise measure). Based on recurring patterns, such as when most people work, the time zones, and the day of the week, the number of hits to a particular service may be predicted based on prior experience. The hours of the day can be broken up into time regions that may be less frequent during certain non-peak times and more frequent during peak times, and the frequency with which hits are calculated can be varied from numbers of hits per day to

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number of hits per time periods, with the time periods being reloaded from the database to the ad server by the controller on a more frequent basis throughout the day. This approach, in effect, alters the granularity with which the hits are monitored. With this approach, the time periods can vary in duration from short duration during peak times to longer duration during non-peak times” (col 6, lines 25-56).

Alberts does not explicitly disclose storing a subscriber advertising profile at the server.

However, Tso discloses advertisers and marketers targeting individual users based on profile, time, location, etc:

“(8) Advertisers and marketers who currently advertise on electronic services also have limited access to users and often can not focus their advertisements due to a lack of information for each user, including positional and demographic information.

(9) Thus, it would be desirable to have an electronic information distribution system which would bypass the limitations stated above” (col 1, lines 33-41).

Tso discloses individual subscriber profiles, storing profiles of subscribers at the server, checking the current time of the user to the time significance of the advertisement, time and location based advertising, and time and location based advertising that takes the user profile into account, and scheduling advertising (Fig. 3, server a17; Fig. 5; and below):

“(62) In addition to the traffic report example as described above, another example would involve the use of the user's profile in addition to the time of day and the location of the user for businesses which wish to advertise their services or products depending on additional criteria. For example, eating establishments may wish to send advertisements to the users located near each establishment's respective vicinity close to mealtimes. These advertisements

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may contain menus or daily specials and, in addition to being targeted to specific users based on their location and the time of day, can also be targeted based on the user's food preferences in subscriber database 53. Thus, for example, if a user is a vegetarian, schedule/resource controller 61 would only forward the InfoBites from vegetarian eating establishments or only forward the InfoBites containing the vegetarian specials from the eating establishments” (col 15, lines 50-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Tso's individual subscriber profiles which can be stored at the server to Albert's user profiles and utilization of servers. One would have been motivated to do this in order to better target content to users and maintain accessibility of user information for targeting.

Additionally, Tso discloses sending information to a user based on factors relating to user location, time of day, user profile and also that the user can adjust or change their profile through user feedback:

“(11). . .What information is sent to the user is dependent on various factors, including: the location of the user; the time of day; and the information contained in a user profile. The user profile indicates the areas of interest of the user and can be dynamically adjusted based on user feedback (col 1, lines 47-53).

(22) InfoFeed interface 57 enables content providers to update data and resources on server A 17 for specific subscriber locations and times. Thus, content providers may feed information only to those InfoCast servers matching a specific criterion (col 6, line 64-col 7, line 1).

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(36) Schedule/resource controller 61 is responsible for filtering the InfoBites that are sent to a user based upon the user's profile as contained in the user's record and subscriber database 53--i.e., a subscriber profile filter, the user's current location--i.e., a locational filter, and the time of day--i.e., a temporal filter. Alternatively, the filtering may be performed on a client, such as client A 23 (col 10, lines 40-48).

(50) FIG. 5 is a flow diagram of the preferred operation of the invention. The description of FIG. 5 will be integrated with a detailed example, wherein the filter used by schedule/resource controller 61 will be based on the time of day, the location of the user, and user profile criteria. Thus, the filter used by schedule/resource controller 61 is composed of three filters, a temporal filter, a positional filter, and a subscriber profile filter (col 13, lines 25-35).

(54) In Block 107, assuming that there is at least one InfoBite that matches the time of day and location of user criteria, schedule/resource controller 61 will send that InfoBite to client A 23 through the use of messaging interface 67" (col 14, lines 15-20).

Alberts does not explicitly disclose user indicated preferences including time of delivery of content.

However, Batachia (20020082912) discloses that the user can adjust a user profile including advertising preference and time of delivery preference:

"[0037] The customers may specify their preferences regarding the type or content of the messages they are interested in. In the case of messages of type offer package, the customers may also indicate the range of acceptability of the prices of the contained offers and times of

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day when they prefer to receive such messages. In customer preferences, the customers may also specify the kind of messages they prefer to receive directly on their wireless devices, the kind of messages that will be accessible only on the platform via HTTP or WAP, and the kinds of messages they prefer to have forwarded to other devices like e-mail systems, faxes, pagers, etc.,. These customer preferences may be used to filter the messages before they reach different Customers' personal devices or personal accounts, to better satisfy the customers' needs and to avoid overwhelming customers with unnecessary messages”.

Batachia further discloses e-commerce utilizing the Internet, a variety of Internet business models, providing information or content to a user in a push and/or pull business model, and the utilizing of advertising (Paragraph 0001, 0002, 0003 and the below):

“[0002] E-commerce uses various business models such as providing a service in return for an advertising space on the customer's display or an online catalog that also allows for online entry of orders”.

Batachia further discloses targeting a customer or customers, that customer preferences can be used to filter offers, that customer preferences can include time delivery period for information/content/offers, and that users can be targeted based on a combination of user indicated preferences as well as vendor predictions or inferences concerning behavior of observed interactions or activity of customers:

“[0022] The offer package engine (which may also be a push/pull platform) 506 generates a package containing one or more offers and/or options that target a particular customer or customers based on policies of the business rules and inference engine 508 and data in the database 510. A factor that may be considered when offers are made is customer

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preferences. Customer preferences may be stored in the database 510 and used to filter offers.

The customer may specify in his or her preferences for example, the intervals of acceptability for different attributes characterizing an offer (price, quantity, etc.), the period(s) of time when he or she agrees to receive offers, etc. In another instance, the vendor takes creates and sends offers using predicted behavior of the customers obtained by inference or previous interactions”.

Batachia further discloses that it is desirable to filter messages in order to better satisfy customers:

“[0037]. . . These customer preferences may be used to filter the messages before they reach different Customers' personal devices or personal accounts, to better satisfy the customers' needs and to avoid overwhelming customers with unnecessary messages”.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Tso's users indicated preferences, targeting based on time and user preferences, and maintaining of a subscriber profile on the server and Batachia's user indicated preferences including time of delivery of content to Alberts utilization of profiles and targeting a user based on a variety of considerations including time or time periods. One would have been motivated to do this in order to better target a user and better satisfy the customer(s).

Also, in regards to claims 2 and 10, Tso further discloses utilizing mailing address information (col 16, lines 5-10;). And, since Alberts discloses targeting a user based on user location and also geographic region (col 7, lines 10-20; col 2, lines 15-25; col 2, lines 30-40) and Alberts discloses adjusting for time regions and time zones (col 6, lines 25-56), and Tso discloses that mailing address information can be utilized (col 16, lines 5-10), it would be

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obvious that Alberts can adjust the time zone to the location of the user which can include a postal code of the user. One would be motivated to do this because postal code is an obvious and convenient way to indicate a geographic region.

Also, in regards to claim 13, Batachia further discloses multiple network interfaces or devices to which the user can have content delivered (Paragraph 0037).

(10) Response to Argument

Examiner notes that the Appellant's 37 CFR 1.131 Affidavit was submitted on 12/12/2005 which is after the Final Rejection dated 10/31/2005 or in the state called After-Final. Examiner notes that Appellant's After-Final submitting of a 37 CFR 1.131 Affidavit goes against MPEP 715.09 on Seasonable Presentation.

However, the central issue presented by the Appellant in the Appeal Brief dated 5/9/2006 is whether the 37 CFR 1.131 Affidavit dated 12/12/2005 can be considered valid. Examiner notes the Interview Summary dated 2/17/2006 which states, "... And, Examiner maintained that Applicant did not prove a conception of invention with due diligence or a reduction to practice in the 1.131 Affidavit dated 12/12/2005. Examiner pointed out, specifically, that the Applicant did not show due diligence along with the Applicant's claim to conception of invention. Examiner referred the Applicant to sections 715.07(a) and 2138.06 of the MPEP for a full disclosure of the what the Applicant must submit in order to prove due diligence. Examiner note that the evidence submitted is insufficient to establish diligence from a date prior to the date of. . .the Batachia reference to either a constructive reduction to practice or an actual reduction to practice."

Examiner notes that 37 CFR 1.131 states that:

"The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records,

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or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.”

The effective date of the Batachia prior art reference is 12/22/2000. The priority date of the Appellant’s invention 09/768,990 is the Appellant’s filing date which is 1/23/2001. Hence, the Applicant’s 37 CFR 1.131 Affidavit must demonstrate a reduction to practice prior to 12/22/2000. Or, the Affidavit must demonstrate a conception of the invention prior to 12/22/2000 combined with due diligence from prior to 12/22/2000 until 1/23/2001.

In the first case, Examiner notes that the 37 CFR 1.131 Affidavit does not present adequate evidence of an actual or constructive reduction to practice. The Affidavit does not present evidence of an actual reduction to practice prior to 12/22/2000. The Affidavit does not present evidence that the Appellant’s invention actually existed or worked. That is, the Affidavit does Not demonstrate “proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose” (from MPEP, 715.07.III). Also, the 37 CFR 1.131 does not present evidence of a constructive reduction to practice prior to 12/22/2000. The Affidavit does not present evidence that the Appellant’s invention was filed prior to 12/22/2000. Hence, the Appellant’s Affidavit does not present evidence of an actual or constructive reduction to practice prior to 12/22/2000.

In the second case, the Affidavit does not demonstrate conception of the invention combined with due diligence. Examiner points out that if the Appellant has shown conception of the invention prior to the Batachia reference, the Appellant must still also show diligence from prior to the effective date of the Batachia reference until the reduction to practice of the Appellant’s invention. In this case, the Appellant must demonstrate diligence from before the

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filing date of the Batachia reference, which is 12/22/2000, until the Appellant's filing date of 1/23/2001. That is, the Appellant must demonstrate diligence from before 12/22/2000 until 1/23/2001.

Examiner points out that the 37 CFR 1.131 Affidavit dated 12/12/2005 presents no evidence of diligence whatsoever. The 12/12/2005 Affidavit does not mention the word diligence. The 12/12/2005 Affidavit does not disclose or demonstrate or state any activity whatsoever between the dates of 12/22/2000 and 1/23/2001. Hence, the 37 CR 1.131 Affidavit dated 12/12/2005 has not demonstrated diligence as required by 37 CFR 1.131. Hence, the 37 CR 1.131 Affidavit is invalid.

The Examiner finds that the following citations from the MPEP are also relevant to the 37 CFR 1.131 Affidavit at hand.

Please see MPEP 715.02.

Please see all of MPEP 715.07.I and also this citation from MPEP 715.07.I:

"A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131

<http://www.uspto.gov/web/offices/pac/mpep/documents/appxr_1_131.htm>.

37 CFR 1.131(b)

<http://www.uspto.gov/web/offices/pac/mpep/documents/appxr_1_131.htm> requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated. . .

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b) <http://www.uspto.gov/web/offices/pac/mpep/documents/appxr_1_131.htm>.

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In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."")

Please see all of MPEP 715.07.III and also this citation from MPEP 715.07.III:

"The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)

<http://www.uspto.gov/web/offices/pac/mpep/documents/0700_715_07_c.htm>), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131

<http://www.uspto.gov/web/offices/pac/mpep/documents/appxr_1_131.htm>)

...

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897

C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also."

Please see all of 715.07(a) and also this citation from 715.07(a):

"What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention."

Also, please see MPEP 2138.06.

Hence, the 37 CFR 1.131 Affidavit dated 12/12/2005 is not valid. Hence, the Batachia reference is still valid prior art. Hence, the 35 USC 103 rejection utilizing Alberts in view of Tso in view of Batachia is still valid. Hence, the Appellant's claims are still rendered obvious by the combination of the prior art cited above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Arthur Duran".

Arthur Duran
Primary Examiner

May 25, 2006

Conferees:

Eric Stamber

A handwritten signature in cursive script, appearing to read "ES".

Jeff Carlson

A handwritten signature in cursive script, appearing to read "JC".